

### **REMARKS**

Claims 1 and 15 are rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. The Examiner contends that the limitation of “temporarily storing the digital media content in the memory for various lengths of time” in claims 1 and 15 is not described in the specification. Claims 2-10, 12-14, 16-24 and 26 are necessarily rejected as being dependent upon the rejection of claims 1 and 15. It is contradictory that the USPTO would make a §112 rejection of claims and allege that one skilled in the art would not know how to make and/or use the invention”, while at the same time rejecting the same claims under §102 and alleging that the invention is anticipated by *Bonomi, et al.* (US 6,769,127). Therefore, the rejection under 35 USC §112 should be withdrawn.

Furthermore, the “temporary storage of digital media” and the “memory for various lengths of time” issues are clearly discussed in the original application at page 6, line 16 to page 7, line 3; and at page 10, lines 10-25.

Claims 1-6 and 14-20 are rejected under 35 U.S.C. §102(e) as being anticipated by *Bonomi, et al.* (U.S. Patent 6,769,127).

Applicants traverse this rejection on the grounds that this reference is defective in supporting a rejection under 35 U.S.C. §102.

Independent Claims 1 and 15 include: “performing processing functions on the digital media content which vary according to a type of digital media content, the functions being able to be performed during and after the digital media content is downloaded.”

The PTO provides in MPEP §2131..."To anticipate a claim, the reference must teach every element of the claim...". Therefore, to sustain this rejection *Bonomi, et al.* must contain all of the claimed elements of independent claims 1 and 15. However, performing processing functions on the digital media content which vary according to a type of digital media content, the functions being able to be performed during and after the digital media content is downloaded, as claimed, are not shown or taught in *Bonomi, et al.* Therefore, the rejection is unsupported by the art and should be withdrawn.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference." *Verdegaal Bros. V. Union Oil Co. Of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)." "The identical invention must be shown in as complete detail as contained in the ...claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Therefore, independent claims 1 and 15 and their respective dependent claims are not anticipated by the prior art reference and are therefore submitted to be allowable.

Furthermore, Applicants traverse this rejection on the grounds that the reference is defective in establishing a *prima facie* case of obviousness for the reasons stated above.

As the PTO recognizes in MPEP § 2142:

... The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness...

The Federal Circuit has held that a reference did not render the claimed combination *prima facie* obvious in *In re Fine*, 873 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988), because inter alia, the examiner ignored a material, claimed, temperature limitation which was absent from the reference. In variant form, the Federal Circuit held in *In re Evanega*, 829 F.2d 1110, 4 USPQ2d 1249 (Fed. Cir. 1987), that there was want of *prima facie* obviousness in that:

The mere absence [from the reference] of an explicit requirement [of the claim] cannot reasonably be construed as an affirmative statement that [the requirement is in the reference].

In *Jones v. Hardy*, 727 F.2d 1524, 220 USPQ 1021 (Fed. Cir 1984), the Federal Circuit reversed a district court holding of invalidity of patents and held that:

The “difference” may have seemed slight (as has often been the case with some of history’s great inventions, e.g., the telephone) but it may also have been the key to success and advancement in the art resulting from the invention. Further, it is irrelevant in determining obviousness that all or all other aspects of the claim may have been well known in the art.

The Federal Circuit has also continually cautioned against myopic focus on the obviousness of the difference between the claimed invention and the prior art rather than on the obviousness vel non of the claimed invention as a whole relative to the prior art as §103 requires. See, e.g., *Hybritech Inc. v. Monoclonal Antibodies, Inc.* 802 F.2d 1367, 1383, 231 USPQ 81, 93 (Fed. Cir. 1986).

In the present case, the reference fails to teach all the limitations of the claimed invention. Thus, the rejection is improper because, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. In this context, 35 USC §103 provides that:

A patent may not be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the *subject matter* as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains ... (Emphasis added)

Because all the limitations of claims 1 and 15 have not been met by the *Bonomi, et al.* patent, it is impossible to render the subject matter as a whole obvious. Thus the explicit terms of the statute have not been met and the examiner has not borne the initial burden of factually supporting any *prima facie* conclusion of obviousness.

In view of the above, it is respectfully submitted that claims 1-10, 12-24 and 26 are in condition for allowance. Accordingly, an early Notice of Allowance is courteously solicited.

Respectfully submitted,



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